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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/451,574	11/30/1999	JAMES L. APPLE	99-049-MIS	9234

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05/17/2002

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EXAMINER

WERNER, FRANK E

ART UNIT

PAPER NUMBER

3652

DATE MAILED: 05/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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UNITED STATES DEPARTMENT OF COMMERCE
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on Feb. 20, 2002
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-7 and 22 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-7 and 22 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been:
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 3652

Detail¹Action

1. Claims 1-7 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re base claims 1 and 22, no library ~~cell~~ structure ~~(shelves, wall, etc.)~~ has been set forth; moreover, no motive means to move the arms, hands, etc., (claim 1) or robot ~~(claim 22)~~ has been set forth; also re claim 22, no means has been set forth to mount the robot units and re base claims 1 and 22, it is not understood what function occurs during the manipulation of the storage units. Re claim 4, it is not understood what line 2 structurally refers to.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-7 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheatham et al (,569-cited by Applicants) in view of Sander (,239) or Mason (,088).

Cheatham et al disclose in at least figure 1, an unnumbered center column (floor mounted) along axis 30, opposed first and second arms 28 rotatable along the column, raisable/lowerable hands 12a and 12b, etc. mounted on the arms and cellular library 44, etc., but do not disclose independently movable hands and arms which is disclosed by Sander (28, 30, etc.) or Mason (18, 20, 36, 101, etc.) and in view of the same, it would have been obvious to have substituted separate rotatable arm mountings to increase the flexibility of the apparatus as taught by either secondary reference. Re claim 2, it would have been obvious to have substituted conventional equivalent ceiling mountings of the first column, if desired, as this would have been known warehouse mountings of manipulators. Re claim 3, Mason (18, 19, 36, 37, etc.) teaches and renders obvious the utilization of longitudinally movable hands along the arms. Re claim 5, Sander (46, 22, etc.) teaches the obvious desirability of mounting a column within a column, if desired.

5. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Japanese Patent (,505).

The Japanese Patent discloses independently movable robots 31A and 31B accessing storage units 10 in cells 2, etc. It would have been obvious to have substituted the conventional handling of equivalent storage units, such as data storage units, if desired.

6. Applicant's arguments filed February 20, 2002 have been fully considered but they are not persuasive. Re the "Remarks" on pages 3 to 7 concerning the "112" rejections, the same are not well-taken since it does not appear from the above rejections that claims 1-7 and 22 conform to the provisions of 35 U.S.C. 112, 2nd paragraph. Further, re the "112" and the below 103" rejections, it should be noted that *is the measure of invention. Limitations in the specification* "the claimed subject matter, not the specification, cannot be read into the claims for the purpose of avoiding the prior art" (and "112" rejections). In re Self, 213 USPQ 1, 5 (CCPA); In re Priest, 199 USPQ 11, 15 (CCPA 1978). Moreover, with Applicants' over-reliance on the specification to define the apparatus, it is not apparent from the claims what Applicants are seeking for their patent monopoly for up to the next 20 years.

Re the "Remarks" on pages 7-13, the same again are not well-taken since each of Cheatham et al, Sander and Mason are each directed to plural movable material handling transfer arms (with Sander and Mason having the teaching of independently movable transfer arms) *and thus,* the reference combinations would appear to be correct, analogous and obviously combinable. Moreover, with regard to the obviousness case citations, attention should be directed to In re Lainson wherein the following was held: "The question of obviousness, however, is so closely tied to the facts of each particular case that prior decisions in cases involving different facts are ordinarily of little value in reaching a decision".

Re the "Remarks" on pages 13 & 14 concerning the Japanese Patent (,505), attention should be directed to the above rejection. Moreover, it should be further noted that the claim does not at least claim that both robots service the same storage area.

Art Unit: 3652

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication should be directed to Frank Werner at telephone number 703-308-1140.

Summary:

Claims 1-7 and 22 rejected.

Final Rejection – SSP 3 mos.

FW/aeg
May 15, 2002

Frank E. Werner
5/02
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PRIMARY EXAMINER
GROUP 2400 3652